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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,643	10/05/2001	Yoichi Ozawa	210090US0PCT	4356
22850	7590	12/23/2003		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER PADEN, CAROLYN A				
ART UNIT		PAPER NUMBER		
1761				

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,643

Applicant(s)

OZAWA ET AL.

Examiner

Carolyn A Paden

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10-31-03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-10, 13 and 15-47 is/are pending in the application.
- 4a) Of the above claim(s) 1-3, 11, 12 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-8, 13, 15-19 and 29-32 is/are rejected.
- 7) ☒ Claim(s) 9, 10, 20-28, 33 and 39-47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Claims 4-10, 13 and 15-47 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 09/968,979. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is not seen that the recitation soybean germ of the product by process claims versus the recitation of the oil made by the process alone constitutes unobviousness.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 4-10, 13 and 15-47 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 09/968,979 which has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of the copending application. The claims in the co-pending case are directed an oil product made by a specific process that utilizes soybean germ as a starting material. It is not seen that there is a patentable distinction between the two oils from the germ of soybean.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Claims 9, 10, 20-28, 33 and 39-47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (5,952,230) taken with Bartsch (4,556,573) and further in view of Christianson (4,495,207) for reasons of record.

Applicant argues that there is no disclosure in the primary reference to the extraction of oil from soybean germ or embryo. This argument has been considered but is not persuasive. Kim discloses that soybean embryo is an excellent starting material for valuable extracts such as isoflavones. It is the examiners understanding that these components are oily by themselves. Although Christianson is not specifically related to soybeans, it teaches the general concept of obtaining food components from the germ of a cereal. Thus the combination of Kim and Christianson teach that is well known in the art to utilize cereal germ as a source of edible material and that this material contains oil. To substitute the germ of soybean for the extract the oil from the germ of soybean instead of the whole soybean would have been an obvious substitution of one starting material for another. Thus while there is not express discussion of extraction, extraction of oil from Kim would have been an alternative way of utilized this valuable food item in a liquid form. Also Kim suggests extraction of materials from the soybean germ. Kim is not the only reference relied upon for this rejection. The rejection further depends upon Bartesch. Although Bartesch uses the whole soybean, it is the examiners position that any soybean starting material could be equally extracted utilizing the Bartesch

process. The fact that applicant selected a specific small fraction of soybeans does not alone constitute unobvious. The amount of germ and oil produced is not very high but producing valuable, nutritional edible oils for premium prices is well known in the art. One needs to merely go to the grocery store to discover that a whole variety of premium edible oils are now available to the consumer. So the fact that Bartesch may have used a large-scale process is not alone seen to overcome the rejection.

Claims 7, 10 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim taken with Bartesch and in view of Christianson as applied to claims 4-6 above, and further in view of Tokue "Properties" article for reasons of record.

Applicant argues that the reference is directed to laboratory results and not to commercial products. This argument has been considered but is not persuasive. One of ordinary skill in the art would recognize that the composition of a soybean component would not be modified by the mass of the starting material. Further the fact that the oil has particular cholesterol lowering properties is not seen to be at issue because it is not a part of the claims.

Application/Control Number: 09/868,643
Art Unit: 1761

Page 7


Claims 7,8,13-19,31,32 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim taken with Bartsch and in view of Christianson as applied to claim 4-6 above and further in view of Tokue "Properties" article as applied to claims 7, 10 and 29-31 and further in view of Menshitsu ("Sterol Composition" article) for reasons of record.

Applicant's arguments concerning this reference were discussed above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn A Paden whose telephone number is (571) 272-1403. The examiner can normally be reached on Monday to Friday from 7 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano, can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


CAROLYN PADEN 12-17-03
PRIMARY EXAMINER
GROUP 1300 1761